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Unuted Sates Patent and Trademark Office
Box Comments -Patents
Commissioner for Patents
Washington, DC 20231

Attention: Mr. Robert W. Bahr

**Re: Comments on Notice of Proposed Rulemaking for Implementing the
Publication of Patent Application after 18 Months**

The Japan Machinery Center for Trade and Investment (JMC) hereby submits comments on Notice of Proposed Rulemaking, Federal Register Vol. 65, No. 66, April,5, 2000, Changes To Implement Eighteen-Month Publication of Patent Applications.

JMC is an association of 380 firms that manufacture and export machinery products worldwide. JMC was established in 1952 under Japan's Export and Import Transactions Law to represent the interests of Japanese machinery exporters and investors.

JMC has some of concerns about the proposed regulation as discussed below and we thank you in advance for taking these comments into account before issuing any final regulation.

Comments on the Proposed Regulation

1. Explanation of Third Party Submission in Published Application

Rule 1.99. Third party submission in published application. (d) A submission under this section may not include any explanation of the patents, publications, or any other information

We believe that indications and simple explanations as to the parts relevant to the published application can be useful for both the Examiner and the applicant in assessing the relevancy. In particular, we think that when the art is complex, or the literature voluminous, such indications and explanations may be necessary to understand the relevancy of the literature. Therefore, we question the need of this kind of limitation.

2. Time Limitation of Third Party Submission in Published Application.

Rule 1.99(e). A submission under this section must be filed within two months of the date of publication of the application or prior to the mailing of a notice of allowance, whichever is earlier. Any submission under this section not filed within this period is permitted only when the patent or publications could not have been submitted to the Office earlier and must also be accompanied by the processing fee

It is often the case that the first time third parties become aware of the existence of an application is after it is published. Thus, third parties should be given at least three months to prepare a related publication and submit it. Therefore, regardless of the Examiner's duty to review the publication, we believe that "whichever is earlier" should be changed to "whichever is later."

3. Abandonment by Violation of Duty of Notifying Foreign Application.

Rule 1.137. Revival of abandoned application. (f) abandonment for failure to notify the Office of a foreign filing. A non-provisional application abandoned . . . for failure to timely notify the Office of the filing of an application in a foreign country . . . may be revived only pursuant to paragraph (b) of this section.

This provision indicates that the abandonment here is treated the same as ordinary "unintentional abandonment." However, as for the abandonment here, it would be a serious negligence since the applicant who, in order to avoid laying open his patent, intentionally endeavors to select an exceptional form of treatment, and the applicant does not fulfill his/her obligation which he/she assumed. An applicant must make a nonpublication request only in situations in which he is positive that he will not file in a foreign country. In order to prevent frivolous requests for nonpublication and requests by fraud, this provision on abandonment should include punitive measures.

Further, situations in which applications that were published by a redacted copy and it turns out that the redacted copy improperly omitted parts which should be published should similarly be treated severely.

4. Fee for Non-Publication Request

Rule 1.213. Nonpublication request. (a) . . . the application will not be published . . . provided: (1) A (nonpublication) request is submitted with the application upon filing; (2) The request states in a conspicuous manner that the application is not to be published . . . ; (3) The request contains certification that the invention disclosed in the application has not been and will not be the subject of an application filed in another country

This rule does not require a fee to a request for nonpublication. However, because such a request is serious and requires exceptional treatment, a substantial fee should be charged.

5. Fee of Request for Redacted Copy Publication.

Rule 1.217. Publication of a redacted copy of an application.
(d)(3) Each submission under paragraph (d)(1) or (d)(2) of this paragraph must also be accompanied by the processing fee set forth in § 1.17(i)

It is appropriate that, when an application is published by a redacted copy, the applicants are required to submit a certificate of foreign application and the corresponding translations, as well as a marked-up copy of the application showing the redactions in brackets and a certification that the redacted copy of the application eliminates only the part that is not contained in any foreign application. The processing fee required for this treatment, however, is only \$130.00 under Rule 1.17.

For the applicants to receive this kind of complicated and exceptional treatment in which the contents of the application partly remain unpublished until the issuance of the patent, which results in third parties not knowing these contents, and forces an unnecessary burden on the public, the applicants should be charged significant fee, for example, more than \$500.

6. Clarification of “Sufficient time” to be removed from the publication process.

Rule 1.211(a). (3) The publication has issued as a patent in sufficient time to be removed from the publication process;

Rule 1.211(e). if the application is not published under this section, the publication fee (if paid) will be refunded.

According to these provisions, the publication fee is refunded where the application has issued as a patent in “sufficient time” to be removed from the publication process. The rules, however, do not clarify the “sufficient time” and leave it to the USPTO’s discretion. It will not be preferable for some applicants to get a refund, while others do not, despite their situations appearing to be the same, except for the USPTO’s clerical convenience. Since these rules involve an applicant’s monetary interest, there should be some objective standards to determine the “sufficient time”. For example, an application should be removed from the publication process where an issue fee is paid within 17 months from the filing date of the application.

We thank you again for your kind consideration of these comments.

Sincerely yours,

Shuji Ogawa
Executive Managing Director
Japan Machinery Center for Trade and Investment